

REMARKS

The present application was filed on December 15, 2003 with claims 1-33. Claims 1, 10, 16, 29 and 31-33 are the independent claims.

In the final Office Action, the Examiner rejects claims 1-33 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,091,765 to Pietzold, III et al. (hereinafter "Pietzold").

In this response, Applicants amend claims 1, 10, 16 and 31-33 and respectfully traverse the rejection for at least the following reasons.

Applicants first note that the present rejection and the non-final rejection mailed September 25, 2006 appear to be substantially the same rejection made by the Examiner in the first non-final Office Action mailed October 5, 2005. Applicants responded with a traversal of the §102(b) rejection based on Pietzold, which resulted in the Examiner withdrawing the §102(b) rejection based on Pietzold in a second non-final Office Action mailed March 23, 2006. In that second Action, the Examiner combined Pietzold with a second reference in a §103(a) rejection. Applicants traversed the §103(a) rejection in their response dated June 23, 2006. The Examiner reasserted the previously-withdrawn §102(b) rejection based on Pietzold in a third non-final Office Action mailed September 25, 2006. Applicants understand that while there does not exist a "rejection estoppel" (wherein an examiner cannot reapply the same rejection that was previously applied, traversed and withdrawn), there should at least be an attempt to provide compact prosecution of a case such that an applicant is not burdened with the cost of readdressing substantially the same rejections over a year after addressing them the first time.

Nonetheless, Applicants address the present rejection below.

While Applicants believe that the claims as filed are patentable over the art cited by the Examiner, Applicants have nonetheless amended claims 1, 10, 16 and 31-33 without prejudice solely to expedite prosecution of the application by clarifying the claimed subject matter.

Regarding the §102(b) rejection of claims 1-33, Applicants respectfully assert that Pietzold fails to teach or suggest all of the limitations in claims 1-33, for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Pietzold does not meet this basic legal requirement, as will be explained below.

Amended claim 1 recites a method of preconditioning a computer-controllable device. The method comprises determining at least one anticipated context with which the device may be associated, and determining at least one mode of operation associated with the at least one anticipated context such that the at least one mode of operation may be effectuated before or at a time when the anticipated context is at least partially realized, where the determination of the at least one mode of operation further comprises identifying at least one configuration parameter useable for a subsequent time period and pre-fetching the configuration parameter. Support for the amendment is shown at, for example, page 9, lines 5-9 of the specification.

By way of example only, the present specification (at page 7, lines 4-27) shows the invention may precondition a software defined radio (SDR)-enabled device to configure its SDR dynamically as its operational context changes during, for example, the course of a day. For example, the invention considers the possibility in which the SDR-enabled device may be expected to be used in the same location for multiple purposes and it would thus be advantageous for the device to be preconditioned to allow its operation for such purposes. For instance, an SDR-enabled cellular phone may be used for both business and personal purposes, and for each purpose a different carrier, carrier plan, and carrier technology may have to be utilized. Based on, for example, the phone number called, the SDR-enabled phone may select the appropriate carrier, carrier plan, and carrier technology to use. This may be made possible by making the collection of necessary configuration parameters already available in the SDR-enabled device so as to allow the device to make a selection among these parameters based on locally and dynamically derived criteria, e.g., the number to which a call is placed. This, in turn, may be made possible by the SDR-enabled device, and/or a provider service for configuration parameters, anticipating the collection of potential context situations and corresponding operational modes that the device may encounter during, e.g., the course of a day, and making available the appropriate SDR configuration parameters to the device in advance. Thus, advantageously, principles of the invention may precondition a device based on past history, phone

plan subscriptions, the set of applications that may be run and the requirements that they impose on the underlying communications network, external network conditions and so on.

Applicants respectfully disagree with the Examiner with regard to claim 1 as being anticipated by Pietzold. Specifically, Applicants respectfully disagree that Pietzold discloses the concepts of “preconditioning” and “anticipated context.” Both of these terms apply to events or conditions that are expected in the future. Both of these terms refer to action/operations occurring at the present time in preparation (preconditioning) of operational modalities that the device will experience at some future time (anticipated context). For example, FIG. 2 of the present application contains an extensive, yet not exhaustive, collection of anticipated contexts 200 that can be considered.

In contrast, Pietzold discloses a configurable device that operates “in current” time. As column 5, lines 55-60 explains, the device in Pietzold responds to instructions provided by the user to configure its current operational mode. In particular, the configuration is specifically responsive to current or currently desired operational conditions. This user-initiated operation does not contain any element of preconditioning or anticipation.

Furthermore, Pietzold refers exclusively to the radio subsystem of a single device (see claim 1 in column 45, lines 36-67). The entire disclosure of Pietzold discloses exclusively how input from a user effectuates the configuration of the radio subsystem in response to immediate needs or conditions. Principles of the present invention relate the entire device, and even though used in illustrative embodiments, the device is not required to contain a configurable radio subsystem. Any one (or a combination of) computer-controlled part(s) of the device in the invention is allowed to be preconditioned and have its operation effectuated based on anticipated context. That is, principles of the present invention may be applicable not only to the SDR in a device, but to its communication subsystem in general, its input/output modality capabilities, display fonts, and so on.

Finally, Pietzold discloses of a device that reacts in response to instructions provided through the user input module 26 that is used “for selecting the transmitter and receiver modes of operations and for selecting the communications signaling system” of a “field configurable radio frequency communications system” (see Pietzold at claim 1, column 45, lines 36-37 and 53-56). Principles of the present invention do not require input by the user to effectuate the configuration of the device

in the field. Since, in accordance with principles of the present invention, the device is preconfigured based on anticipated context, the device can change its mode of operation without user intervention. Modes of operation can change automatically whenever the device senses the existence of at least one of the anticipated context, e.g., switch service plans between the same or different service providers based on time of day. The latter may not require change of radio modulation techniques because the service plans could operate by a provider or providers that use the same radio modulation technique, as Pietzold discloses at column 1, lines 51-53.

In response to Applicants' arguments, the Examiner contends "that the art of record discloses 'The system includes a non volatile memory that is adapted to receive and store instructions for configuring the system. A user selects the mode of operation and the signaling scheme, and instructions and software are downloaded from the memory into the system and configure the system as selected by the user' which reads on precondition of a computer controllable device." (See the Office Action at page 11, last paragraph). Applicants respectfully disagree. As noted above, the device in Pietzold responds to instructions provided by the user to configure its current operational mode. (See Pietzold at column 5, lines 55-60). Thus, the user-initiated operation does not contain any element of preconditioning or anticipation.

Based on the above, Applicants believe that claim 1 is allowable. Also, since independent claims 10, 16 and 31-33 recite the concept of "projected" or "anticipated" context," Applicants believe that such claims are also allowable.

Applicants note that, in the present Office Action the Examiner has again argued that Pietzold discloses the notion of preconditioning since, as the Examiner states at page 2, "'this is an inherent feature because the computer controllable device has some type of software programmed on it."

Applicants have set out their arguments above regarding why Pietzold clearly fails to disclose the notion of preconditioning. However, regarding the Examiner's point on inherency, Applicants provide the following remarks.

Apparently by raising the issue of inherency, the Examiner acknowledges that Pietzold does not expressly teach or suggest the claimed features of preconditioning and anticipated context. However, although each and every aspect of the invention is not disclosed in Pietzold, the Examiner attempts to overcome this deficiency in the rejection by arguing that the missing limitations are

inherent in Pietzold. However, the Examiner fails to satisfy the necessary criteria for maintaining a rejection of the claims under §102 based on inherency for at least the following reasons.

The Pietzold reference does not contain the disclosure which is necessary to support a rejection of a claim on the basis of inherency. According to the Court of Customs and Patent Appeals (CCPA), “Inherency does not mean that a thing might be done, or that it might happen, ...; but it must be disclosed, if inherency is claimed, that the thing will necessarily happen.” *In re Draeger et al.*, 150 F.2d 572, 574 (CCPA 1945) (emphasis supplied). Furthermore, the well settled law “requires that inherency may not be established by possibilities and probabilities. The evidence must show that the inherency is necessary and inevitable.” *Interchemical Corp. v. Watson*, 145 F.Supp. 179, 182, 111 USPQ 78, 79 (D. D.C. 1956) (emphasis supplied), *aff’d*, 251 F.2d 390, 116 USPQ 119 (D.C. Cir. 1958).

Simply stating that “the computer controllable device [in Pietzold] has some type of software programmed on it” does not mean that the claimed steps of determining at least one anticipated context with which the device may be associated, and then determining at least one mode of operation associated with the at least one anticipated context such that the at least one mode of operation may be effectuated before or at a time when the anticipated context is at least partially realized, must necessarily flow from that assertion.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such basis and/or technical reasoning has been provided by the Examiner in the present Office Action.

Regarding claim 29, Pietzold fails to disclose the concept of “a target of communication,” as in the claimed invention.

Regarding the claims that depend from the various independent claims, Applicants assert that such claims are patentable not only due to their respective dependence on such claims, but also because such claims recite patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-33 are in condition for allowance, and respectfully request withdrawal of the §102(b) rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being more prominent than the last name "Lewis".

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